

REMARKS

Applicant requests favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-8 were pending in the application and were rejected in the Office Action. By way of this amendment, Applicant has amended claims 1-4, 6, and 8, without adding new matter. In addition, Applicant has canceled claim 7, without prejudice or disclaimer. Accordingly, claims 1-6 and 8 are respectfully resubmitted for further consideration.

Preliminarily, Applicant notes that claims 6 and 8 were not rejected based on prior art, *i.e.*, the claims were only rejected for formalistic reasons under 35 U.S.C. § 112, as later discussed in detail. Accordingly, Applicant asserts that as these formalistic reasons have been fully resolved by way of the amendments made herein to claim 6 and 8, both of these claims should be in condition for allowance.

1. Information Disclosure Statements

Applicant appreciates the indication (by way of Examiner initials) that the Examiner considered the reference submitted with the Information Disclosure Statement (“IDS”) filed with the application on July 14, 2003. Applicant notes, however, that the Examiner failed to include a similar indication for the references submitted with the IDS filed on November 19, 2003. Accordingly, Applicant respectfully requests that the next paper issued by the Patent & Trademark include an Examiner initialed copy of the PTO/SB/08 that listed the references submitted with the IDS filed November 19, 2003.

2. Objection to the Drawings

The Examiner objected to the drawings for failure to show the “double pinion planetary gear set” recited in claim 7. This objection is now moot due to the cancellation of claim 7, without prejudice or disclaimer. Accordingly, the objection should be withdrawn.

3. Objection to Claim 6

The Examiner objected to claim 6 for a formalistic reason that has been fully obviated by way of the amendments made herein to claim 6. Accordingly, the objection is now moot and, therefore, should be withdrawn.

4. Rejection of Claims 1-8 under 35 U.S.C. § 112

The Examiner rejected claims 1-8 under 35 U.S.C. § 112, ¶ 1 for allegedly failing to comply with the enablement requirement. This rejection is now moot with respect to claim 7, which has been canceled without prejudice or disclaimer. Moreover, with respect to claims 1-6 and 8, Applicant respectfully asserts that the grounds for this rejection have been fully obviated by way of the amendments made herein to claim 1 (*i.e.*, the claim from which claims 2-6 depend) and claim 8. In light of the foregoing, Applicant respectfully requests a withdrawal of the rejection of claims 1-6 and 8 under § 112, ¶ 1.

5. Rejections of Claims 1-5 under 35 U.S.C. §§ 102(b), 103(a)

The Examiner rejected claims 1-4 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,302,820 ("Ried"). In addition, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Ried. For the following reasons, Applicant respectfully traverses these rejections.

As amended, claim 1 (*i.e.*, the claim from which claims 2-5 depend) recites a speed change gear for an automatic transmission, which includes among other possible things (*italic emphasis added*):

- 1) an input portion for inputting an input rotation from a power source;
- 2) an output portion disposed substantially coaxially with the input portion and outputting an output rotation of the speed change gear; and
- 3) a plurality of planetary gear sets including a compound planetary gear set, the plurality of the planetary gear sets providing a plurality of power conductive paths to an area defined between the input portion and the output portion, the plurality of the planetary gear sets comprising:
 - a first clutch;
 - a second clutch;
 - a third clutch;
 - a first brake; and
 - a second brake,

wherein the clutches and the brakes are configured to be selectively engaged and disengaged in such a manner that the planetary gear sets change a rotation from the input portion at a corresponding gear change ratio by selecting one of the plurality of the power conductive paths, thereby outputting the thus changed rotation to the output portion,

wherein combinations of engaged clutches and brakes and combinations of multiple engaged clutches define at least six successive forward gears and one reverse gear,

wherein one of the plurality of the planetary gear sets is a speed reduction planetary gear set for continuously reducing the input rotation and outputting the thus reduced rotation,

wherein in the first through the fifth forward gears, the first clutch and/or the second clutch is/are engaged to transfer the reduced rotation from the speed reduction planetary gear set to the compound planetary gear set,

wherein in the sixth forward gear, neither the first clutch nor the second clutch is engaged,

wherein the third clutch, which is a direct clutch for outputting the input rotation to the compound planetary gear set, is disposed radially outward relative to a first ring gear of the speed reduction planetary gear set,

wherein the first ring gear has an outer periphery that is provided with a clutch hub, and

wherein the clutch hub constitutes the direct clutch and is an input member to the third clutch.

As hereafter explained, Ried fails to teach or suggest at least the two above-italicized limitations recited in claim 1.

First, as shown in Figure 2 of the instant application, in first gear through fifth gear, the first clutch C1 and/or the second clutch C2 is/are engaged, whereas in sixth gear, neither the first clutch C1 nor the second clutch C2 is engaged. In contrast, in Ried's sixth gear, clutch K1 (which the Examiner analogizes to the recited first clutch) is engaged. Accordingly, for this reason alone, Ried fails to teach or suggest each of the limitations of claim 1.

Second, as shown in Figures 6 and 7 of the instant application, in one embodiment of the present invention, the third clutch C3 is "disposed radially outward relative to" the ring gear R1 "of the speed reduction planetary gear set" G1, as recited in claim 1. In contrast, both Ried's text and figures fail to teach or suggest this spatial relationship. With respect to Ried's figures, the Office Action analogizes: (a) Ried's input transmission structure TE (which is provided with a ring gear HE) to the "speed reduction planetary gear set"; and (b) Ried's friction clutch K2 to the "third clutch". However, as clearly shown in Figure 1 of Ried, the third clutch (*i.e.*, friction clutch K2) is not "disposed radially outward" relative to the ring gear HE of the speed reduction planetary gear set (*i.e.*, input transmission structure TE). Accordingly, for this additional reason, Ried fails to teach or suggest each of the limitations of claim 1.

As Ried fails to teach or suggest each of the limitations of claim 1, Reid standing alone can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. §§ 102(b), or 103(a). Moreover, as claims 2-5 depend from claim 1, each of these dependent claims is also allowable over Ried, without regard to the other patentable limitations recited therein. Accordingly, Applicant respectfully requests a withdrawal of the rejections of claims 1-5 under §§ 102(b), and 103(a).

6. Rejection of Claim 7

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Ried in view of U.S. Patent No. 6,231,471 ("Park"). Applicant respectfully submits that this rejection is now moot due to the cancellation of claim 7, without prejudice or disclaimer. Accordingly, the rejection should be withdrawn.

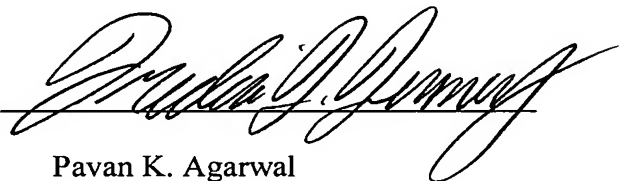
CONCLUSION

For the aforementioned reasons, claims 1-6, and 8 are in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

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By



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